

Application Serial No. 09/647,279
Attorney Docket No. 114474-13-FESI00001
Amendment and Response to Office Action, Dated December 9, 2005

REMARKS/ARGUMENTS

Claims 1 and 11-20 are now pending. Claims 1 and 6 are independent. Claim 6 was previously withdrawn; however, rejoinder is now requested.

Applicant respectfully requests reconsideration of the application.

I. Independent Claim 1

Claim 1 reads as follows:

1. A plastic syringe barrel, comprising:

a nozzle portion in which an outer cylinder and an inner cylinder are formed, and

a luer lock portion formed in the nozzle portion and between an inner peripheral surface of the outer cylinder and an outer peripheral surface of the inner cylinder,

wherein a helically continuous screw thread is formed on the inner peripheral surface of the outer cylinder, and

the inner peripheral surface of the outer cylinder has a roughened surface.

The Office Action concedes that nothing in Moncada – or any other reference of record – teaches roughening a surface in the nozzle portion of a syringe barrel. Nor does Moncada teach or suggest that increased frictional force is desirable at the nozzle. The Office Action argues that it would be obvious to apply roughening to the threaded luer lock (item 118 of Fig. 5) of the Moncada adaptor (item 80) because Moncada describes that teeth may be added to an entirely different structure – the ears (item 112) of the male Luer lock portion (item 106) that form an engagement means between the adaptor and the syringe barrel (item 84). But, as the Office Action concedes, Moncada's ears are positioned at the opposite end of the adaptor from the luer lock (item 118) – and the nozzle. There is nothing in Moncada to suggest that the teeth,

Application Serial No. 09/647,279
Attorney Docket No. 114474-13-FESI00001
Amendment and Response to Office Action, Dated December 9, 2005

or the ears, may be re-positioned to the nozzle or any other location along the combined adaptor-syringe structure.

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. The Office Action directly concedes that Moncada does not teach or suggest roughening a surface of the nozzle portion. The Office Action does not allege that the Porfano reference teaches roughening any surface. When a limitation is conceded to be totally absent from the art, no amount of hindsight conjecture can support obviousness.

The deficiencies of a reference cannot be remedied by the Examiner's general conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Each step in an obviousness inquiry must be supported by "substantial evidence." MPEP § 2142-2144.09. Pursuant to 37 C.F.R. § 1.104(d)(2), Applicant requests a reference or an affidavit to support any "motivation to modify" Moncada or Porfano to roughen a surface in the nozzle portion of a syringe, or to move roughening from one end of a device to the other.

In sum, nothing in the cited references – Moncada and Porfano, individually or in combination – teaches or suggests a syringe barrel as claimed having "a nozzle portion in which an outer cylinder and an inner cylinder are formed, a luer lock portion formed in the nozzle portion and between an inner peripheral surface of the outer cylinder and an outer peripheral surface of the inner cylinder, wherein a helically continuous screw thread is formed on the inner peripheral surface of the outer cylinder, and the inner peripheral surface of the outer cylinder has a roughened surface." Thus, independent claim 1 is not anticipated, taught, or suggested by the art of record.

Application Serial No. 09/647,279
Attorney Docket No. 114474-13-FESI00001
Amendment and Response to Office Action, Dated December 9, 2005

II. Claim 6 Should Be Rejoined

In view of subsequent amendments to claim 1, restriction between claim 1 and claim 6 is no longer proper. Pursuant to 37 C.F.R. § 1.144, Applicant requests that claim 6 be rejoined.

Claim 6 is similar enough to claim 1 to be considered patentable for reasons analogous to those discussed above with respect to claim 1.

III. Dependent Claims

Dependent claims 11-20 recite features that further distinguish the art and are patentable with independent claims 1 and 6, for at least the reasons discussed above.

Application Serial No. 09/647,279
Attorney Docket No. 114474-13-FESI00001
Amendment and Response to Office Action, Dated December 9, 2005

In view of the foregoing, Applicant respectfully submits that the claims are in condition for allowance. Applicant therefore requests that the application be passed to issuance. The Examiner may telephone Applicant's undersigned counsel at the number concerning prosecution of this application.

Enclosed with this paper is a Petition for Extension of Time for one month. In the event that any further extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114474-13-FESI00001

Respectfully submitted,
WILLKIE FARR & GALLAGHER, LLP

Dated: December 9, 2005

By: 
Leslie M. Spencer
Registration No. 47,105

WILLKIE FARR & GALLAGHER, LLP
787 Seventh Ave.
New York, New York 10019
212-728-8782
212-728-9782 Fax
lspencer@willkie.com